

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF WASHINGTON  
AT TACOMA

DERRAL FLEMING, and MAG  
ENTERPRISES, LLC,

Plaintiff,

v.

SCOTT PARNELL, and SAMSON  
SPORTS, LLC,

Defendant.

CASE NO. C13-5062 BHS

ORDER DENYING PLAINTIFFS'  
MOTION FOR ISSUANCE OF  
REQUEST TO REGISTER OF  
COPYRIGHTS PURSUANT TO 17  
U.S.C. § 411(B)(2), AND STAY  
PENDING RESPONSE

This matter comes before the Court on Plaintiffs' Motion for Issuance of Request to Register of Copyrights Pursuant to 17 U.S.C. § 411(b)(2), and Stay Pending Response (Dkt. 76). The Court has considered the motion and the remainder of the file herein.

**FACTUAL & PROCEDURAL BACKGROUND**

This case relates to five copyright registrations for technical drawings. Dkt. 84, at 2–4. Three registrations were submitted on April 3, 2012 (2012 registrations): VAu 1-098-698, VAu 1-098-703, and VAu 1-098-701. The remaining two were submitted on February 27, 2013 (2013 registrations): VA 1-860-367, and VA 1-876-794. *Id.* All five registrations list Kevin Frederickson as the sole author. *Id.*

On January 29, 2013, Plaintiffs filed a civil complaint alleging that: (1) Defendants do not own the copyrights asserted and Plaintiffs did not infringe on any copyright owned by Defendants; (2) the copyrights are invalid; (3) the copyrights are actually owned and authored by

1 Plaintiff Mr. Fleming; (4) Defendants breached fiduciary duties to Plaintiffs by misappropriating  
 2 and/or converting partnership assets; and (5) the partnership has dissolved and the Court should  
 3 equitably distribute the partnership assets, including the disputed copyrights. Dkt. 1. On March  
 4 6, 2013, Defendants counterclaimed for: (1) two counts of copyright infringement against  
 5 Plaintiffs; (2) two counts of false advertising/false designation of origin/reverse passing  
 6 off/unfair competition against Plaintiffs; (3) two counts of breach of fiduciary duty against  
 7 Plaintiff Derral Fleming; (4) two counts of breach of the duty of good faith and fair dealing  
 8 against Plaintiff Derral Fleming; (5) improper accounting; (6) conversion of partnership  
 9 property; (7) tortious interference with business relations; (8) unjust enrichment; and (9) breach  
 10 of contract against Plaintiff MAG Enterprises. Dkt. 7.

11 In addition to this action, Defendant initiated an action in Clark County Superior Court in  
 12 November of 2012. Dkt. 1 at 8; Dkt. 7 at 7. The State Court appointed Mr. Fleming as the  
 13 Winding Up Partner on September 27, 2013 because “[t]he hardship imposed on Mr. Fleming by  
 14 ordering the Partnership to completely cease work during the pendency of this case outweighs  
 15 any potential hardship imposed on Samson Sports LLC.” Dkt. 83-9 at 3. However, the parties  
 16 agree that the state court does not have jurisdiction to resolve whether the copyrights in this case  
 17 are valid and whether either party infringed upon them. Dkt. 1 at 11; Dkt. 7 at 8.

### 18 **LEGAL STANDARD**

19 Litigation related to copyright disputes is regulated by the Copyright Act of 1976, 17  
 20 U.S.C. § 101, *et seq.* Registration is a prerequisite to sue under the Copyright Act of 1976. 17  
 21 U.S.C. § 411. A party challenging the validity of a registration must comply with 17 U.S.C. §  
 22 411(b), which provides that:

(1) A certificate of registration satisfies the requirements of this section and section 412, regardless of whether the certificate contains any inaccurate information, unless--

(A) the inaccurate information was included on the application for copyright registration with knowledge that it was inaccurate; and

(B) the inaccuracy of the information, if known, would have caused the Register of Copyrights to refuse registration.

(2) In any case in which inaccurate information described under paragraph (1) is alleged, the court shall request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration.

In one of the few instances in which the Copyright Register was called upon to deliver its opinion to a federal court, the Register stated that:

17 U.S.C. § 411(b)(2) was amended to ensure that no court holds that a certificate is invalid due to what it considers to be a misstatement on an application without first obtaining the input of the Register as to whether the application was properly filed or, in the words of § 411(b)(2), “whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration.”

Response of the Register of Copyrights to Request Pursuant to 17 U.S.C. § 411(b)(2) at 10–11, *Olem Shoe Corp. v. Wash. Shoe Co.*, No. 1:09–cv–23494 (S.D. Fla. Oct. 14, 2010).

Therefore, the Court must, first, determine the facts underlying the “inaccurate information” and whether such information was known, and then, only once such determination has been made, send a request to the Register of Copyright to determine the materiality of the inaccurate information. *See id.*; 17 U.S.C. § 411(b).

### **MOTION FOR ISSUANCE OF REQUEST TO REGISTER OF COPYRIGHTS**

On February 10, 2014, Plaintiff filed this motion pursuant to 17 U.S.C. § 411(b)(2), asking the court to submit questions to the Register of Copyrights and stay the proceedings pending a response on those questions. For each question, Plaintiffs ask if the Register would have refused the registration, for each application, if it had known: (1) that “Samson Sports LLC was not the owner of the copyrights” (2) “that the person listed as ‘sole author,’ Kevin

1 Frederickson, was not, in fact, the sole author;” (3) “that the person listed as ‘sole author’, Kevin  
2 Frederickson, did not contribute protectable creative expression of his own registered work;” (4)  
3 that “although Samson Sports characterized the work as unpublished, Samson Sports distributed  
4 the work for viewing, review and use to third parties, and submitted the work to state and  
5 municipal agencies to become part of publicly accessible records, before filing the registration;”  
6 and (5) that “although any of the individual issues described above would not render the  
7 application unregistrable, the combination of such errors in each application were known.” Dkt.  
8 76. Plaintiff also wishes to ask if the Register would have refused registration if it had known:  
9 (1) that “Derral Fleming had been appointed statutory Winding-Up Partner by a court having  
10 jurisdiction over the matter,” for the 2013 registrations; (2) “that the deposit materials filed with  
11 the Copyright Office do not match the work asserted by the Applicant as the registered work,”  
12 for the 2012 registrations; and (3) that the applicant “failed to notify the Copyright Register that  
13 the work for which registration is sought is, at the time of the application, subject of two lawsuits  
14 in which an [sic] opposing parties plead that the person listed as the ‘sole author’...was not, in  
15 fact, the sole author and further that the works lack copyright protectable content, so that the  
16 Register could request further information from the applicant in order to verify the applicant’s  
17 claims,” for the 2013 registrations. *Id.*

18 Specifically, Plaintiff argues that the copyright registrations are invalid because: (1) at the  
19 time the applications were filed, the copies were owned by the Partnership, not by Samson  
20 Sports, and Samson Sports was aware of this inaccuracy; (2) Defendants’ deposit materials do  
21 not match the works asserted to be covered by the Registrations; (3) if there was an author of the  
22 works, the group of Mr. Fleming, Mr. Wallway, Mr. Parnell, and Mr. Fredrickson were the  
23 authors, not Mr. Frederickson alone; (4) no work contained Mr. Frederickson’s expression  
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1 because he was directed to make each drawing by the group; (5) the works were initially  
2 registered as unpublished works in April 2012, but the February 2013 registrations purported to  
3 correct the 2012 registrations by adding the publishing date of November 22, 2009; (6)  
4 Defendants should transfer control of the pending applications to Mr. Fleming as the Winding  
5 Up Partner; (7) if not for any one of the reasons above, the copyright should be invalidated based  
6 on the cumulative effect of the deficiencies; and (8) Defendants failed to notify the Register of  
7 this case and the action in state court. Dkt. 76 at 4–6.

8 On February 24, 2014, Defendants responded, arguing that: (1) Samson Sports was the  
9 owner of the copyrights during the time of 2012 registrations and the Partnership was the owner  
10 during the 2013 registrations; (2) Plaintiffs do not allege that the deposit materials included  
11 inaccurate information; (3) Mr. Frederickson was the author of the works because he fixed them  
12 in a tangible medium; (4) Plaintiff has not alleged anything inaccurate about Mr. Frederickson's  
13 "expression," and the works are sufficiently original under copyright law; (5) Samson Sports  
14 mistakenly listed the 2012 registrations as unpublished, but corrected the error in the 2013  
15 registrations according to Copyright Register instructions; (6) the state court order conflicts with  
16 Plaintiff's request to transfer control of the pending applications to Mr. Fleming, who was  
17 appointed as Winding Up Partner because he needed to use the works to earn a living; (7)  
18 cumulative errors do not satisfy the § 411(b) test that the applicant had *knowledge* of inaccurate  
19 information; and (8) there is no authority requiring disclosure of copyright litigation to the  
20 Register of Copyrights and the copyright application does not require such information. Dkt. 82.

21 On February 28, 2014, Plaintiffs replied that Defendants misstate the legal definition of  
22 "author" and the reasoning in *Olem Show Corp. v. Wash. Shoe Co.*, 09-23494-CIV, 2011 WL  
23 6202282 (S.D. Fla. Dec. 1, 2011), and ignores the plain language of § 411(b)(2). Dkt. 88.  
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1 Plaintiffs also contend that Defendants filed 2014 applications which are also invalid. *Id.* In  
2 addition, Plaintiffs directed the Court to three points made in its summary judgment motion (Dkt.  
3 89): (1) Defendants knowingly filed the 2012 registrations under Samson Sports LLC rather than  
4 the partnership; (2) Defendants knowingly filed works as unpublished when they were, in fact,  
5 published; and (3) Defendants knowingly listed Mr. Frederickson as the sole author despite his  
6 admission to the contrary. *Id.*

7 On March 4, 2014, Defendant filed a motion to file a surreply. Dkt. 102. In its proposed  
8 surreply, Defendants only cites a case which questions the validity of *Koster*, a case cited by  
9 Plaintiff in its reply. Dkt. 102. Defendant argues that Defendants' cited case characterizes  
10 *Koster* as "departing significantly from Ninth Circuit precedent." *Id.* at 1–2. Because the Court  
11 otherwise reviews authorities cited by the parties, Defendants' Motion for Leave to File a  
12 Surreply should be granted.

13 In addition to this motion, both Plaintiffs and Defendants currently have summary  
14 judgment motions pending before the Court. Dkt. 89, 94. Some of the disputed factual issues in  
15 those motions include: when the partnership between the parties was formed, who owned and  
16 authored the copyrights, and whether listing the 2012 registrations as unpublished was a  
17 scrivener's error or a knowing misstatement. *Id.*

### 18 **DISCUSSION**

19 Many of the factual circumstances surrounding the copyright registrations in this case are  
20 hotly disputed between the parties, both in this motion and in the motions for summary  
21 judgment. At this point, it has not been determined who owned the copyrights, who authored the  
22 copyrights, whether Defendants knowingly misstated that the 2012 registrations were  
23 unpublished, and whether Defendants knowingly misstated information regarding this action or  
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1 the state court action in the 2013 registrations. Those determinations are within the purview of  
2 this Court, not the Register of Copyrights. Therefore, it would be imprudent on the eve of the  
3 Court deciding dispositive motions and a jury trial in which the facts will be determined.

4 Additionally, 17 U.S.C. § 411(b)(2) was meant to glean the Register's opinion before a  
5 court invalidates a copyright. This case is not at that point. Rather, the record is unclear  
6 on many of the underlying facts, and the statute was not designed to permit the submission to the  
7 Register of hypothetical questions when the disputed facts would ultimately have to be resolved  
8 by the finder of fact.

9 Once such factual determinations have been made, a request may be sent for the  
10 Register's analysis regarding the materiality of any knowing misstatements in the disputed  
11 registrations. Until such time, this motion is premature and should be denied without prejudice.

## 12 **ORDER**

13 It is hereby **ORDERED** that:

- 14 1. Plaintiff's Motion for Issuance of Request to Register of Copyrights Pursuant to 17  
15 U.S.C. § 411(b)(2), and Stay Pending Response (Dkt. 76) is **DENIED** without  
16 prejudice as premature.
- 17 2. Defendants' Motion for Leave to File Surreply (Dkt. 102) is **GRANTED** and the  
18 Court accepts the proposed Surreply as Defendants' Surreply.

19 Dated this 24<sup>th</sup> day of March, 2014.

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22 BENJAMIN H. SETTLE  
23 United States District Judge  
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